

## **REMARKS**

### **1. Status of Claims**

Claims 1-15 and 17-21 were pending in the Application. On July 24, 2009, a Decision on Appeal from the Board of Patent Appeals and Interferences reversed the rejection of claim 5. On October 1, 2009, the Examiner issued a new Office Action ("Office Action") rejecting claims 1-3 and 5 and subsequently reissued that Office Action on October 29, 2009 under the signature of a Technology Center Director.

Applicants have amended claims 1, 10 and 12, and canceled claims 5 and 9, all without prejudice or disclaimer. Applicants have added new claims 22-23. New claim 23 is directed to the subject matter of previous claim 5, as rewritten in independent form. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-4, 6-8, 10-15 and 17-23 will remain pending in the application.

### **2. Claims after Appeal**

Applicants respectfully submit that claims 1-15 and 17-21 were in the case and not canceled by the decision of the BPAI. Applicants have amended independent claim 1 to further clarify the claimed subject matter and have rewritten claim 5 as new claim 23 in independent form.

### **3. Rejections under 35 USC § 103(a)**

On page 2 of the Office Action, the Examiner rejected claim 5 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 5,589,865 to Beeson ("Beeson '865").

Applicants have canceled claim 5 and added new independent claim 23 that is directed to the subject matter of previous claim 5.

Applicants respectfully note that the Board reversed the Examiner's anticipation rejection of claim 5 over Beeson '865 such that the claimed elements are not taught or inherent in Beeson '865. Moreover, the Examiner has not cited to any other reference

that is combinable with Beeson '865 to show those missing elements and then describe why such combination would be obvious.

Moreover, the Examiner apparently previously argued that Beeson '865 taught open cell foam, but the BPAI apparently disagreed. In fact, the cited reference describes a "tight-celled foam sponge" and a lint-free felt which suggests that open cell foam material is not inherent, nor fairly suggested by Beeson '865. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

Accordingly, Applicants respectfully submit that claim 23 is patentable over the cited reference.

Accordingly, Applicant respectfully submits that claims 1-4, 6-8, 10-15 and 17-23 are in condition for allowance and respectfully request that the Examiner withdraw the rejections.

#### **4. Conclusion Of Remarks**

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

#### **5. Authorization**

No fee is believed due with this response. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-670.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The

Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-670.

Respectfully submitted,

/George M. Macdonald/

---

George M. Macdonald, Reg. No. 39,284  
Attorney for Applicant  
Telephone (203) 924-3180

PITNEY BOWES INC.  
Intellectual Property and Technology Law Department  
35 Waterview Drive, MSC 26-22  
Shelton, CT 06484